

REMARKS

In the March 18, 2010 final Office Action, claims 2, 4 and 9-18 stand rejected in view of prior art. No other objections or rejections were made in the Office Action. Claims 3, 5-8 and 19-39 are also pending, but withdrawn from consideration.

Status of Claims and Amendments

In response to the March 18, 2010 final Office Action, none of the claims are being amended by the current Amendment. Claims 3, 5-8 and 19-38 are withdrawn from further consideration as being drawn to non-elected Species. Thus, claims 2-38 are pending, with claims 2 and 3 now being the only independent claims. Claims 2, 4 and 9-18 (claim 2 being independent) are currently being examined on merits. Reexamination and reconsideration of the pending claims 2, 4 and 9-18 are respectfully requested in view of above amendments and the following comments.

Interview Cancelled

The undersigned had an Interview scheduled with Examiner Rogers on June 9, 2010. Unfortunately, Examiner Rogers and her Supervisor realized the Interview could not be conducted, and cancelled the Interview of June 7, 2010. Examiner Rogers agreed to conduct an Interview after the end June. Applicants understand the scheduling conflict of the Examiners and appreciate the offer to conduct an Interview in July. However, Applicants no longer wish to conduct an Interview. Thus, it is not necessary for Examiner Rogers to contact the undersigned upon receiving this Response.

Applicants believe that claims 2, 4 and 9-18 are allowable over the prior art as explained below, and respectfully request reconsideration of claims 2, 4 and 9-18 in view of the following comments.

Rejections - 35 U.S.C. § 103

In paragraphs 2-7 of the Office Action, claims 2, 4 and 9-18 stand rejected under 35 U.S.C. §103(a) as follows:

- (A) Claims 2, 4, 12 and 13 stand rejected as being unpatentable (obvious) over the Rhodes '143 patent;
- (B) Claims 9-11 stand rejected as being unpatentable (obvious) over the Rhodes '143 patent in view of U.S. Patent No. 4,984,433 to Worthington;
- (C) Claim 14 stands rejected as being unpatentable (obvious) over the Rhodes '143 patent in view of U.S. Patent No. 6,205,797 to Maeda and U.S. Patent No. 6,050,100 to Belding;
- (D) Claim 15 stands rejected as being unpatentable (obvious) over the Rhodes '143 patent in view of U.S. Patent No. 6,205,797 to Maeda;
- (E) Claims 16 and 17 stand rejected as being unpatentable (obvious) over the Rhodes '143 patent in view of U.S. Patent No. 5,547,018 to Takahashi et al.; and
- (F) Claim 18 stands rejected as being unpatentable (obvious) over the Rhodes '143 patent in view of U.S. Patent No. 5,590,831 to Manson et al.

In response, Applicants traverse the rejections as explained below. Specifically, independent claim 2 requires, *inter alia*, “a heat source side refrigerant circuit including a compression mechanism and a heat source side heat exchanger, only the compression mechanism of the compression mechanism and the heat source side heat exchanger being used in common with the first and second utilization side refrigerant circuits.” Clearly this arrangement is ***not*** disclosed or suggested by the Rhodes patent, the Worthington patent, the Maeda patent, the Belding patent, the Takahashi et al. patent, and/or the Manson et al. patent, singularly or in combination. The claims rejected in rejections (B) – (F) all now depend from independent claim 2.

More specifically, with respect to rejection (A) the Office Action acknowledges that the Rhodes patent fails to explicitly teach a heat source side heat exchanger in the heat source side refrigerant circuit. However, the Office Action asserts that it is obvious to replace the accumulator (96) of the Rhodes patent with a heat exchanger in order to allegedly ensure that mixed phase refrigerant is in the liquid phase before being sent to the inlet of the compressor.

However, if the accumulator (96) of the Rhodes patent is replaced with a heat exchanger, the heat exchanger would be used in common with the first and the second

utilization side refrigerant circuits. Thus, if the accumulator (96) of the Rhodes patent is replaced with a heat exchanger as suggested in the Office Action, the arrangement of independent claim 2 would not result. Accordingly withdrawal of rejection (a) of claims 2, 4, 12 and 13 is respectfully requested.

Alleged Intended Use Limitations

On page 4 of the Office Action, the Office Action alleges that the limitations "...configured to treat...", "configured for alternating...", "...configured for exchanging heat...", and "...only the compression mechanism of the compression mechanism and the heat source side heat exchanger being used..." have all been considered recitations of intended use and do not structurally differentiate the claimed structure from the prior art. Applicant disagrees, especially with respect to the recitation "a heat source side refrigerant circuit including a compression mechanism and a heat source side heat exchanger, only the compression mechanism of the compression mechanism and the heat source side heat exchanger being used in common with the first and second utilization side refrigerant circuits" in independent claim 2. This limitation positively describes how the parts of the claimed air conditioning system operate. As mentioned above, if the accumulator (96) of the Rhodes patent is replaced with a heat exchanger as suggested in the Office Action, the arrangement of independent claim 2 would not result. Rather, the Rhodes patent, if modified as suggested in the Office Action, would not even be capable of operating as claimed.

Accordingly, Applicants respectfully assert that the assertions in the Office Action seem to imply a *per se* categorization of language following the words "configured to" as statements of intended use (not a positive limitation). Applicants respectfully submit that no such rule exists, and that an analysis applying such a rule is improper.

In the entire MPEP, the *phrase* "configured to" is mentioned only once in a listing of claimed elements in a combination. M.P.E.P. § 2143. That section discusses *Leapfrog Enterprises, Inc. v. Fisher-Price, Inc.*, 485 F.3d 1157, 82 U.S.P.Q.2d 1687 (Fed. Cir. 2007). In *Leapfrog*, the claimed interactive learning device included, *inter alia*, "a reader configured to communicate the identity of the depiction to the processor." The Federal Circuit considered the description of the functionality of the reader to be a positive limitation in this analysis, interpreting the reader element as "a reader that allows the processor to automatically identify the inserted book." *See also In re Stauffer*, Appeal No. 2007-1445

(Fed. Cir. Jul. 24, 2008) (*nonprecedential*) (in analyzing whether the prior art taught “a controller configured to detect caller ID information from an incoming call”, requiring the prior art to teach a controller that performed the described function, not just any controller). These holdings by the Federal Circuit also conform to the understanding by the Board of Patent Appeals and Interferences. In *Ex parte Shinjo et al.*, Appeal No. 2005-0070, *slip opin.* at 4 (BPAI 2005), the examiner relied on M.P.E.P. 2114 in support of the proposition that functional limitations are not entitled to patentable weight in an apparatus claim. The Board rejected the examiner's position, stating that “it is fundamental that each claim limitation must be given *weight* and consideration in determining patentability, whether under § 102 or § 103. Although a claimed apparatus cannot be distinguished over a prior art apparatus based on how the claimed apparatus functions, a functional limitation may impart structure to a claimed apparatus, and it is incumbent upon the examiner to demonstrate that a prior art apparatus is capable of performing the claimed function.” (Emphasis added).

Applicants respectfully submit that “a heat source side refrigerant circuit including a compression mechanism and a heat source side heat exchanger, only the compression mechanism of the compression mechanism and the heat source side heat exchanger being used in common with the first and second utilization side refrigerant circuits” is structurally distinguishable from the structure of the Rhodes patent if the accumulator (96) of the Rhodes patent is replaced with a heat exchanger as suggested in the Office Action. Thus, any rationale stating that a prior art device satisfies the claim limitation because it is capable of operating as claimed is erroneous.

Thus, Applicants respectfully submit that a *prima facie* case of obviousness has not been established by the current Office Action. As discussed in §2142 of the MPEP, “[t]he examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness.” In the current Office Action, there is no evidence on the record of prior art which teaches or even suggests the arrangement of independent claim 2.

The remaining references cited in rejections (B) – (F) do not account for the deficiencies of the Rhodes patent with respect to independent claim 2. In fact, as seen in the Office Action, these references are merely relied upon to allegedly disclose features of selected dependent claims. Thus, even if the references cited in rejections (B) – (F) were somehow combined with the Rhodes patent as asserted in the Office Action, “a heat source

side refrigerant circuit including a compression mechanism and a heat source side heat exchanger, only the compression mechanism of the compression mechanism and the heat source side heat exchanger being used in common with the first and second utilization side refrigerant circuits” as required by independent claim 2 would not result. Accordingly, withdrawal of rejections (B) – (F) is also respectfully requested.

Under U.S. patent law, the mere fact that the prior art can be modified does *not* make the modification obvious, unless an *apparent reason* exists based on evidence in the record or scientific reasoning for one of ordinary skill in the art to make the modification. See, KSR Int’l Co. v. Teleflex Inc., 127 S.Ct. 1727, 1741 (2007). The KSR Court noted that obviousness cannot be proven merely by showing that the elements of a claimed device were known in the prior art; it must be shown that those of ordinary skill in the art would have had some “apparent reason to combine the known elements in the fashion claimed.” Id. at 1741. In this case, the current record lacks any apparent reason, suggestion or expectation of success for combining the patents to create Applicants’ unique arrangement of independent claim 2, as now amended.

* * *

In view of the comments, Applicants respectfully assert that claims 2, 4 and 9-18 are now in condition for allowance. Furthermore, Applicants respectfully request that withdrawn claims 3, 5-8 and 19-38 be rejoined if appropriate, upon allowance of a generic and/or linking claim or claims. In any case, reexamination and reconsideration of the pending claims are respectfully requested.

Respectfully submitted,

/Patrick A. Hilsmier/
Patrick A. Hilsmier
Reg. No. 46,034

GLOBAL IP COUNSELORS, LLP
1233 Twentieth Street, NW, Suite 700
Washington, DC 20036
(202)-293-0444

Dated: June 17, 2010

S:\06-JUN10-YTY\DK-US040214 Amendment.doc